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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,281	03/12/2004	Murat Quadir	LOREAL 3.0-005 I	7212

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L'OREAL USA/ PATENT DEPARTMENT
30 TERMINAL AVENUE
CLARK, NJ 07066

EXAMINER

RAE, CHARLESWORTH E

ART UNIT	PAPER NUMBER
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1614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/799,281

Applicant(s)

QUADIR, MURAT

Examiner

Charleswort Rae

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 43-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 and 47-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date
:9/2/04;9/27/04;10/18/04;1/13/06.

DETAILED ACTION

Status of the Claims

Claims 1-51 are currently pending in this application and are the subject of this Office action.

Claims 43-46 are withdrawn from consideration for examination purposes for being directed towards non-elected subject matter.

Claims 1-42 and 47-51 are presented for examination.

Restriction/Election

Applicant's election with traverse of Group I and POSS of Formula I, in the amount of up to about 40% by weight of the product, and an amount of personal care ingredient of at least about 10%, is acknowledged and made of record.

Applicant asserts that examining all claims of Groups I-V together would not impose a serious burden in view of the fact that "personal care products" encompasses shampoos, nail polishes, conditioners, and mascaras, as well as deodorants, body washes, shaving creams, etc. Applicant's assertion is not deemed to be persuasive as these personal care products are distinct e.g. a nail polish is not used as a conditioner and vice versa, and have acquired different status in the art, and encompass different combination of ingredients, which reasonably confer different cosmetological and functional characteristics to the personal care products. The restriction requirement is therefore made final.

Nonstatutory Obviousness-Type Double-Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-42 and 47-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of US Patent Application No. 10,790,280 (App. '280) in view of US Patent Application Publication 2002/0128414 A1 (James et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are either anticipated by, or would have been obvious in view of the referenced claims.

The instant claimed invention overlaps with the subject matter claimed in reference App. '280. For example, reference claim 1 of App. '280 is directed towards a personal care product comprising at least one EPOSS having a rigid three dimensional cage structure comprising nine or more Si atoms within its cage structure, said EPOSS being present in an amount effective to provide a desired degree of a predetermined personal care property and at least one personal care ingredient. Unlike the instant claims, App. '280 does not disclose a cage structure comprising between 6 to 8 Si atoms within its cage structure.

James et al. (US Patent Publication 2002/0128414) disclose a general rigid three dimensional cage structure of a silsesquioxane-based monomeric unit (i.e. Structure I), with 8 Si atoms within the cage structure, wherein all of the Si atoms are completely saturated and all of said Si atoms are bound to at least one other Si atom within the said cage structure through an oxygen atom, and wherein said cage structure has at least two completed sides, each of said Si atoms being bound to at least 1 R group with no more than 1 of said Si atoms being bound to more than 2 R groups, said POSS being present in an amount preferably at 20 to 85 weight percent in a monomeric mixture,

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where each R is independently selected from a group consisting of a C1-C12 monovalent hydrocarbon radical, a C1-C12 monovalent hydrocarbon radical containing ether linkages, a halogen-substituted C1-C12 monovalent hydrocarbon radical, and a halogen-substituted C1-C12 monovalent hydrocarbon radical containing ether linkages (page 2, paragraph 0020 – 0024). In particular, James et al. teach POSS where R is cyclopentyl or isobutyl, which overlaps with the instant claimed invention (page 5, paragraph 0074).

James et al. also teach copolymers prepared from a monomeric mixture comprising a) an itaconate ester at about 0 to about 60 weight percent, preferably about 20 to about 55 weight percent; and a POSS compound of structure I at about 3 to about 85 weight percent, preferably about 5 to about 60 weight percent, and more preferably about 10 to about 25 weight percent. James et al. teach copolymers that are useful as ophthalmic lenses (page 1, paragraph 0001). James et al. disclose that the POSS compounds useful as monomers in accordance with the invention can be produced by general methods known in the art (page 1, paragraph 0019).

Thus, someone of skill in the art at the time the instant invention was made would have found it obvious to create the instant claimed invention with a reasonable expectation of success in view of App. '280 in view of James et al.

This is a provisional obviousness-type double patenting rejection because the conflicting claims of the copending applications have not in fact been patented.

Claim rejections – 35 USC 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 4, 5, 6, 7, 8, 9, 10, 12, 13, 14, 15, 16, 17, 18, 19, 20, and 21 are rejected under 35 USC 102(b) as being anticipated by James et al. (US Patent Publication 2002/0128414). The discussion of James et al. regarding the above nonstatutory obviousness-type double patenting rejection is incorporated by reference. To reiterate, James et al. teach POSS where R is cyclopentyl or isobutyl, which overlaps with the instant claimed invention (page 5, paragraph 0074).

James et al. teach copolymers that are useful as ophthalmic lenses (page 1, paragraph 0001). The instant application states that a “[p]ersonal care product(s) is meant broadly and encompass products used for skin and hair and for their care, treatment or protection, as well as products for other cosmetic purposes (page 9, para, 0016, lines 1-5). A copolymer ophthalmic lens comprising POSS where R is isobutyl or cyclopentyl reasonably is considered to be a personal care ingredient as ophthalmic lenses are personal items in view of the specification. As stated above, Jamest et al disclose a POSS compound of structure I at about 3 to about 85 weight percent, which overlaps with the POSS amounts of the instant application. The term “predetermined

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personal care property" recited in claim 1, for example, is not concisely or clearly defined in the instant specification. This limitation is reasonably considered to be the intended use of the personal care ingredient. To the extent that a contact lens is solid, the instant claimed limitations overlap with the limitations taught by James et al. Thus, instant claims 1, 4, 5, 6, 7, 8, 9, 10, 12, 13, 14, 15, 16, 17, 18, 19, 20, and 21 are rejected under 35 USC 102(b) as being anticipated by James et al. (US Patent Publication 2002/0128414). James et al. do not teach other personal care ingredients

Claim rejections – 35 USC 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-42, and 47-51 are rejected as being unpatentable over James et al., in view of Hutchins et al. (5,804,173).

The above discussions of James et al. regarding the nonstatutory obviousness-type double patenting and 102(b) rejections are incorporated by reference.

Hutchins et al. personal care compositions comprising a copolymer complex and a volatile, hydrophobic solvent component for solubilizing or dispersing the copolymer complex (column 1, lines 7-9). Hutchins et al. teach the copolymer complex is formed by complexing a fatty acid with a copolymer, wherein the copolymer comprises a hydrophobic monomer, a hydrophilic monomer such that at least 1% by weight of the total copolymer, comprises hydrophilic monomers bearing nitrogen functional groups, and optionally a hydrophobic macromonomer (column 1, lines 9-15). Hutchins et al. teach that the compositions of the invention provide improved delivery, deposition and retention to the hair and skin (column 1, lines 15-16). Hutchins et al. also teach that the copolymers of the invention can be formulated into a wide variety of product types, including mousses, gels, lotions, creams, ointments, tonics, sprays, aerosols, shampoos, conditioners, rinses, bar soaps, hand and body lotions, mascaras, antiperspirants, deodorants and the like (column 15, line 48 to column 20, line 67).

In view of the teaching of Hutchins et al. teach that the compositions provide improved delivery, deposition and retention to the hair and skin, someone of skill in the art would have been motivated at the time the instant invention was created to combine the teachings of James et al. and Hutchins et al. (column 1, lines 15-16). Thus, it would have been obvious to someone of skill in the art at the time the instant invention was made to create the instant invention with a reasonable expectation of success in view of James et al., and in view of Hutchins et al.

Claim rejections – 112 – First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

LACK OF WRITTEN DESCRIPTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH:

Claims 1-42 and 47-51 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification discloses chemicals, which meet the written description and enablement provisions of 35 USC 112, first paragraph. However, claims 1-42 and 47-51 are directed to encompass chemicals of general formulas which only correspond in some undefined way to specifically instantly disclosed chemicals. None of these compounds meet the written description provision of 35 USC § 112, first paragraph, due to lacking chemical structural information for what they are and chemical structures are highly variant and encompass a myriad of possibilities. The compounds encompassed by these claims are only described in general terms. No structure/function information is disclosed to reasonably correlate a specific compound with its substantivity properties or the intended personal care effect to be achieved in practicing the instant claimed invention. Thus, the specification provides insufficient written description to support the genus encompassed by the claims.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must

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convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

With the exception of the above specifically disclosed chemical structures, the skilled artisan cannot envision the detailed chemical structure of the encompassed derivatives, analogs, etc., regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The chemical structure itself is required. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993) and Amgen Inc. V. Chugai Pharmaceutical Co. Ltd., 18 USPQ2d 1016. In Fiddes v. Baird, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence. Finally, University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1404, 1405 held that:

...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966.

Therefore, only the chemically structurally defined chemicals, but not the full breadth of the claim(s) meet the written description provision of 35 USC § 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC § 112 is severable from its enablement

provision. (See page 1115.)

Claim rejections – 35 USC 112 – Second Paragraph

The following is a quotation of the second paragraph of 35 USC 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-42, and 47-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the term "POSS" but fails to state the full meaning of the term at the first occurrence the term is recited in the claim. This limitation is vague and indefinite because it is not clear what "POSS" means. It is suggested that this specific rejection may be overcome by either replacing the term "POSS" with the full name or, alternatively, amend the claim by inserting the full name in parenthesis at the first occurrence of the term "POSS" in the claim.

Claims 2-42, and 47-51 are rejected for the same reason as claim 1, from which they depend, as these claims fail to correct the deficiency of claim 1.

Claim 8 recites the limitation "of about 40% or less," which encompasses a product with zero POSS. This limitation lacks proper antecedent basis as claim 7 from which it depends recite "at least about 0.10%. This claim is therefore deemed to be indefinite.

Claim 9 recites "an amount of about 20% or less," which encompasses zero POSS. This limitation lacks antecedent basis as it depends from claim 8, which depends from claim 7. This claim is also deemed to be indefinite.

Claim 10 recites "an amount of about 10% or less," and is also deemed to be indefinite for lacking proper antecedent basis as it depends from claim 9, which depends from claim 7.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlesworth Rae whose telephone number is 571-272-6029. The examiner can normally be reached between 8 a.m. to 4:30 p.m. Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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23 March 2007
CER


ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER